

REMARKS

The present Submission fully complies with M.P.E.P. § 706.07(h)(II).

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

Status of the Claims and Specification

In the present Reply, claims 1, 7 and 8 have been amended. Also, claim 10 has been added. Thus, claims 1-10 are pending in the present application.

No new matter has been added by way of these amendments and new claim because each amendment and new claim is supported by the present specification and various Figures. For example, the amendment to claim 1 has support throughout the written description as well as the Figures. Specifically, the raised portion **5B** is disposed toward the inner side of the diaper (see the paragraph bridging pages 3-4 of the present specification; Figure 2); the elastic member **54d** in the raised portion **5B** is fixed between two sheet materials (see, e.g., Figures 2 and 4); and the folded back portion **57** is located between the skin-contacting surface portion **5A** and the raised portion **5B** (see page 4, last paragraph of the specification). The amendments to claims 7 and 8 are merely for clarification purposes and editorial in nature. Thus, one of skill in the art would understand these amendments are not narrowing in scope, and Applicants in no way are conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents. New claim 10 is added for the Examiner's consideration, which has support in the

last paragraph of page 4 and the second paragraph of page 5 of the present specification. Thus, no new matter has been added.

The amendment to the specification also does not add new matter as can be seen from the various Figures. This amendment is merely correcting a typographical error.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw the objection and all rejections and allow the currently pending claims.

Claim Objection

Claim 7 stands objected to based on an informality (see page 2 of the Office Action). Further, claim 8 stands objected to due to a different informality. These informalities have been addressed (see the claims as presented herein), and thus withdrawal of these objections is respectfully requested.

Issues under 35 U.S.C. § 102(e)

Claims 1, 2 and 6 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Yoshioka '023 (U.S. Patent No. 6,156,023). Applicants respectfully traverse.

The Examiner essentially refers to Figure 3 of the Yoshioka '023 reference as asserted to disclose all claimed features. Applicants respectfully traverse since, e.g., Yoshioka '023 does not a folded back portion as instantly claimed. The Examiner presents Figure 3 of Yoshioka '023 as

having a “folded back portion” next to the “raised portion.” More specifically, the Examiner asserts that 24B and the first of 24C in Figure 3 constitutes a “skin-contacting surface portion,” and that the second of 24C and 24A equals the “raised portion” (see the sentence bridging pages 7-8 of the Office Action). However, such a folded back portion in Yoshioka ‘023, as labeled in the Office Action on page 8, is not in between Yoshioka’s raised and skin-contacting surface portions. Further, the raised and skin-contacting surface portions in the Examiner’s Figure 3 lie in the same plane, without the intervening folded back portion. Thus, Yoshioka ‘023 fails to disclose all instantly claimed features. Since “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” the cited Yoshioka ‘023 reference cannot be a basis for a rejection under § 102. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Reconsideration and withdrawal of this rejection are respectfully requested.

Applicants further note that the Examiner’s Figure 3 presents a raised portion that is not disposed towards the inside of the diaper. Thus, Yoshioka ‘023 fails to disclose another instantly claimed feature. Withdrawal of this rejection under *Verdegaal Bros.* is respectfully requested.

In addition, the Examiner states that the claimed “sets” do not dictate the appearance of the elastic members (see the Office Action at page 7, lines 5-9 from the bottom of the page). Applicants strongly and respectfully disagree since claim 1 clearly recites that the first set of elastic members are disposed and fixed to the skin-contacting surface portion, and the second set of elastic members are disposed and fixed to an approximately widthwise central portion of a

raised portion. Thus, each set of the elastic members lies in a different portion, wherein one of ordinary skill in the art would understand such structural features. Claim 1 even recites “wherein said raised portion is located between said skin-contacting surface portion and a base end of said three-dimensional guard.” Thus, the portions are located in different areas of the absorbent article. Thus, Applicants disagree with the Examiner’s assessment of how the present claims should be interpreted, and reconsideration and withdrawal of this rejection are respectfully requested.

The Examiner’s reasoning at page 7, lines 3-4 from the bottom is not applicable here as well. Such a claimed limitation appears to refer to the cited reference, and not the present invention. Further, if the Examiner is referring to the present invention, the Examiner is essentially discounting claimed features wherein each recited set of elastic members is recited to be in a different portion of the absorbent article (as explained in the preceding paragraph).

Applicants also traverse this rejection since “The single reference must describe and enable the claimed invention, including all claim limitations, with sufficient clarity and detail to establish that the subject matter already existed in the prior art and that its existence was recognized by persons of ordinary skill in the field of the invention.” *See Elan Pharmaceuticals Inc. v. Mayo Foundation for Medical Education and Research*, 64 USPQ2d 1292, 1296 (Fed. Cir. 2002) (citing *Crown Operations International, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1375, 62 USPQ2d 1917, 1921 (Fed. Cir. 2002); *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990) (“the reference must describe the applicant’s claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it”). That is

not the case here since one of skill in the art would not interpret Yoshioka '023 in the manner suggested in the Office Action. There is no "sufficient clarity and detail" in Yoshioka '023 to somehow equate members 24A, 24B and both 24Cs with what is instantly claimed. Thus, Applicants respectfully request withdrawal of this rejection.

Issues under 35 U.S.C. § 102(b)

Claims 7 and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Yoyoda '571 (WO 97/12571). Applicants respectfully traverse.

The Examiner interprets claim 7 so that elastic members are not required for each portion (see, e.g., page 5, lines 7-8 of the Office Action). However, Applicants respectfully submit that pending claim 7, especially as presented herein, is directed to elastic members for each claimed portion. Thus, this rejection has been overcome under *Verdegaal Bros.* Reconsideration and withdrawal of this rejection are respectfully requested.

Request for Interview

If the Examiner will maintain any of the current rejections or will form any new rejections, Applicants herein request an Interview. Applicants further request that the Interview take place before issuance of the next Office Action in an effort to advance prosecution of this application.

Application No.: 10/019,650
Art Unit 3761
Reply to Office Action of March 24, 2005

Docket No.: 0445-0316P

Concluding Remarks

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

John W. Bailey

Registration No.: 32,881

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Rd

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant